

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: W. Scott THIELMAN and)
Robert M. PRICONE)
Serial No.: 10/015,319)
Filed: December 12, 2001)
For: A Process and Apparatus for)
Embossing Precise Microstructures)
and Embossing Tool for Making)
Same)
Group Art Unit: 1732)

Attorney Docket:
013013-026179



RECEIVED
JUN 18 2002
OFFICE OF PETITIONS

**STATEMENT BY PERSON HAVING FIRST HAND KNOWLEDGE THAT
THE NONSIGNING INVENTORS WERE EMPLOYEES OF OR WERE
OTHERWISE OBLIGATED TO AN ENTITY HAVING SUFFICIENT
PROPRIETARY INTEREST IN THE INVENTION WHEN IT WAS MADE**

1. I, Arthur B. Moore, at all relevant times was the Chief Patent Counsel of Avery Dennison Corporation, the putative owner of the above-identified application. I make this statement of facts in support of a petition to accept the above-identified application with the omission of an oath or declaration signed by both of the joint inventors, W. Scott Thielman and Robert M. Pricone, who refuse to sign an oath or declaration. I have read the above-identified specification and claims.

ROBERT M. PRICONE

2. Mr. Pricone was an employee of Avery Dennison Corporation and its predecessor in interest, Stimsonite, from November 7, 1977 to October 5, 2001. Mr. Pricone commenced his

employment with Stimsonite Corporate on November 7, 1977. On April 23, 1991, Mr. Pricone signed a "Noncompetition, Invention and Secrecy Agreement" with Stimsonite. This agreement is attached as Exhibit A1. In July of 1999, Avery Dennison Corporation acquired Stimsonite Corporation. A new Employee Agreement and an Agreement to Arbitrate Claims between Mr. Pricone and Avery Dennison Corporation was entered into on August 27, 1999. These agreements are attached as Exhibit A2. Mr. Pricone's employment with Avery Dennison Corporation ended on October 5, 2001.

3. The terms of the August 1999 Employee Agreement require Mr. Pricone to assign to Avery Dennison "all ideas, discoveries, inventions, contributions and improvements . . . which in any way relate to the Company's business or which result from tasks assigned to Employee by the Company." The Employee Agreement also requires Mr. Pricone "to sign all papers and do such other acts . . . to protect the Company's rights to" patentable subject matter. Based upon this Employee Agreement, Mr. Pricone is contractually obligated to assign to Avery Dennison technology that was fully or partially developed before October 5, 2001.

4. One parent patent application relating to the project of the present application was filed in which Mr. Pricone is named as a co-inventor. Patent Application No. 09/596,240 was filed on June 16, 2000, and named Mr. Pricone as a co-inventor and related to the companion technology to the technology described and claimed in the above-identified patent application. Mr. Pricone assigned his rights in this patent application to Avery Dennison Corporation on January 30, 2001. The assignment document is attached as Exhibit L. He also signed the formal papers for this application, which are attached as Exhibit M.

5. The above-identified continuation-in-part application was prepared by Ronald A. Sandler of Jones, Day, Reavis & Pogue. The application named Mr. Pricone as a co-inventor and related to improvements in the technology claimed in the applications Serial Numbered 09/596,240 and 09/781,756. The continuation-in-part application was filed on December 12, 2001 with an unsigned Declaration.

6. Mr. Pricone developed the invention claimed in the above-identified application prior to October 5, 2001 while he was an employee of Avery Dennison and while his August 1999 Employee Agreement with Avery Dennison was in full force and effect. Some of the work done developing the present invention took place in Germany during the spring of 2001. Avery Dennison possesses travel records, data sheets and reports from this German development activity. These accounts and other records are dated before Mr. Pricone's employment ended in October of 2001.

7. All of the time, materials, costs and expenses related to the inventions disclosed and claimed in the present patent application were paid for by Avery Dennison. These expenditures included the cost of the trip to carry out experiments in Germany and the preparation of the claimed tools by Avery Dennison employees. Mr. Pricone was assigned to and did work on this specific invention as part of his employment with Avery Dennison. Under the terms of the August 1999 Employee Agreement between Mr. Pricone and Avery Dennison Corporation, he is contractually obligated to assign the invention claimed in this continuation-in-part application to Avery Dennison, and to cooperate in executing all related papers.

W. SCOTT THIELMAN

8. Mr. Thielman was an employee of Stimsonite Corporation, Avery Dennison Corporation's predecessor in interest, from April 21, 1993 to January 29, 1999. On the day Mr. Thielman commenced his employment with Stimsonite Corporate he signed a "Noncompetition, Invention and Secrecy Agreement" with Stimsonite. This agreement is attached as Exhibit D.

9. Mr. Thielman's formal employment relationship with Stimsonite ended on January 29, 1999. After his formal employment with Stimsonite ended, Avery Dennison Corporation retained Mr. Thielman's company, Material Testing Technology Company of 840 N. Martin Drive, Palatine, IL, as a consultant. Mr. Thielman sent invoices to Stimsonite and Avery Dennison Corporation through his company. Avery Dennison paid Mr. Thielman an hourly rate for the work he performed. Avery Dennison paid Mr. Thielman and Material Testing Technology Company over \$220,000 for services provided in 2000 and 2001. The last payment by Avery Dennison to Mr. Thielman was on November 12, 2001.

10. Two parent patent applications relating to the project of the present application were filed in which Mr. Thielman is named as a co-inventor or inventor. Patent Application Serial No. 09/596,240 filed on June 16, 2000 named Mr. Thielman as a co-inventor, and Patent Application Serial No. 09/781, 756 filed on February 12, 2001 named Mr. Thielman as an inventor. Both applications relate to companion technology to the technology described and claimed in the above-identified patent application. Even though ostensibly employed as a consultant, consistent with the understanding of the parties that inventions generated on consulting projects funded by Avery Dennison would belong to Avery Dennison, Mr. Thielman

formally assigned his rights in these parent patent applications to Avery Dennison Corporation on January 30, 2001 and February 12, 2001. The assignment documents are attached as Exhibit L. He also signed the Declaration and other formal documents for these applications, which are attached as Exhibit M.

11. After Mr. Thielman assigned the '240 and '756 patent applications to Avery Dennison, he continued his work as a consultant on the project, and continued to bill Avery Dennison for the time that he spent assisting in the development of the inventions claimed in the continuation-in-part application. He charged Avery Dennison \$150 per hour for time that he spent working on the project, and also for all of his expenses related to this work.

12. From March to August of 2001, Material Testing Technology Company sent invoices to Avery Dennison which itemized work Mr. Thielman had done developing the inventions claimed in this continuation-in-part application. Over this time period, Mr. Thielman billed Avery Dennison for over 360 hours spent working on the project. Avery Dennison also paid Mr. Thielman for all of his travel and expenses related to his work developing the present invention, including over \$2,000 for a trip to Germany to work specifically on the invention and the project. Redacted copies of certain Thielman invoices are attached as Exhibit N.

13. All of the time, materials, costs and expenses relating to the inventions disclosed and claimed in this patent application were paid for by Avery Dennison. These expenditures included the cost of the trip to carry out experiments in Germany and the preparation of the specific tools by Avery Dennison employees. Mr. Thielman billed Avery Dennison for the work

he did on these inventions and was paid. Avery Dennison had every expectation that Mr. Thielman would continue to assign to Avery Dennison the inventions that he was paid to develop, as had been the past practice.

14. During the two years of the consulting arrangement between Mr. Thielman and Avery Dennison, Avery Dennison has operated on the understanding that all inventions arising out of projects Mr. Thielman was paid to work on would be the property of Avery Dennison. Mr. Thielman has never acted or said anything inconsistent with this understanding, and has assigned over fifteen inventions to Stimsonite and/or Avery Dennison over the past seven years. If Avery Dennison had known that Mr. Thielman was going to unilaterally change the consulting relationship and claim ownership of the current invention, it would not have continued to retain him nor paid his consulting fees.

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the present application or any patent issued thereon.

Dated: May 23, 2002

By: Arthur B. Moore
Arthur B. Moore
Chief Patent Counsel

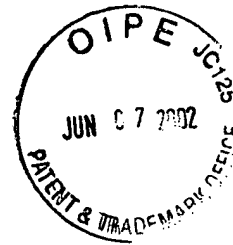
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: W. Scott THIELMAN and)
Robert M. PRICONE)
Serial No.: 10/015,319)
Filed: December 12, 2001)
For: A Process and Apparatus for)
Embossing Precise Microstructures)
and Embossing Tool for Making)
Same)
Group Art Unit: 1732)

Attorney Docket:
013013-026179

RECEIVED

JUN 18 2002



OFFICE OF PETITIONS

**STATEMENT OF FACTS IN SUPPORT OF FILING ON
BEHALF OF NON-SIGNING INVENTORS UNDER 37 C.F.R. § 1.47(b)**

1. I, Arthur B. Moore, during all relevant times, was the Chief Patent Counsel of Avery Dennison Corporation, the putative owner assignee of the above-identified application. I make this statement of facts in support of a petition to accept the above-identified application with the omission of an oath or declaration signed by both of the joint inventors, W. Scott Thielman and Robert M. Pricone, who refuse to sign an oath or declaration.

2. The above cited continuation-in-part application was prepared by Ronald A. Sandler of the law firm of Jones, Day, Reavis & Pogue, in its Chicago office. The application names Mr. Pricone and Mr. Thielman as co-inventors and relates to improvements in the technology claimed in application Serial No. 09/596,240, filed on June 16, 2000, and application Serial No. 09/781,756, filed on February 12, 2001. Both parent applications were assigned by

Mr. Thielman and Mr. Pricone to Avery Dennison Corp. The continuation-in-part application was filed on December 12, 2001, with an unsigned Declaration.

ROBERT M. PRICONE

3. On January 24, 2002, Janice Jackson of Avery Dennison Corporation, acting pursuant to standing instructions from me, sent a copy of the patent application (including the specification, claims and drawings), a Combined Declaration and Power of Attorney for Patent Application ("Declaration") and an assignment document to Mr. Pricone.

4. On February 6, 2002, Mr. Pricone sent me an e-mail acknowledging that he had received the patent application and Declaration. Mr. Pricone also stated in the e-mail that he would not review the patent application or sign the papers unless he was paid \$150 an hour for the time it would take him to review the application. He estimated that he would take between eight and thirty-two hours to review the application. Mr. Pricone's e-mail is attached as Exhibit F. My understanding is that Mr. Pricone had reviewed prior drafts of the application and provided comments to Attorney Sandler, and that Mr. Pricone's comments were reflected in the final version of this application as filed. Mr. Pricone's comments about the patent application are attached as Exhibit G.

5. Nevertheless, on February 12, 2002, I sent Mr. Pricone an e-mail highlighting the differences between the 09/596,240 and 09/781,756 parent applications and the continuation-in-part application. This e-mail is attached as Exhibit H.

6. During the week of March 11, 2002, I spoke with Mr. Pricone on the telephone, and he told me that he had reviewed the patent application and that he had no changes. After this conversation, Mr. Pricone still failed to sign the Declaration and the assignment document.

7. Janice Jackson communicated with me throughout January, February and March of 2002 about her unsuccessful efforts to obtain Mr. Pricone's signed Declaration. On March 22, 2002, Janice Jackson sent me an e-mail stating that she had yet to obtain Mr. Pricone's signature. On the same day I asked Ronald Sandler of Jones, Day, Reavis & Pogue to contact Mr. Pricone to determine whether he was refusing to sign the Declaration. Mr. Sandler sent me an e-mail that afternoon stating that he had talked with Mr. Pricone and that Mr. Pricone now was unwilling to sign the Declaration allegedly because he could not verify the portion of the patent application that had been based on work done by the co-inventor W. Scott Thielman. Ronald Sandler's March 22, 2002 e-mail is attached as Exhibit I, with legal advice redacted.

8. Inventor Robert M. Pricone is a former employee of Avery Dennison Corporation and its predecessor in interest, the Stimsonite Corporation, and was employed by them for almost 24 years. A copy of his relevant employment documents are attached as Exhibits A-1 and A-2. As is apparent from his employment records, Mr. Pricone has a duty to assign to Avery Dennison the present application. See the accompanying Declaration of Arthur B. Moore entitled "Statement By Person Having First Hand Knowledge That The Nonsigning Inventors Were Employees Of Or Otherwise Obligated To An Entity Having Sufficient Proprietary Interest In The Invention When It Was Made."

W. SCOTT THIELMAN

9. On December 13, 2001, shortly after the application was filed, Mr. Thielman e-mailed me and asked who the inventors for the above cited continuation-in-part application were. On December 14, 2001, Mr. Thielman and I received an e-mail from Paulette Haseltine, assistant to Ronald A. Sandler, which stated that Robert M. Pricone and W. Scott Thielman were the named inventors in the application. This e-mail is attached as exhibit J.

10. On January 24, 2002, Janice Jackson of Avery Dennison Corporation sent a copy of the patent application (including the specification, claims and drawings), a Combined Declaration and Power of Attorney for Patent Application ("Declaration") and an assignment document to Mr. Thielman.

11. During the week of February 11, 2002, I spoke to Mr. Thielman about signing the Declaration. Mr. Thielman informed me that he would not sign the Declaration unless he was paid two weeks of consulting fees amounting to \$10,000. I told Mr. Thielman that his demands were entirely inappropriate, but that I would consider the demands and contact him later.

12. On February 19, 2002, I sent Mr. Thielman a letter stating that although Avery Dennison rarely pays former employees for reviewing patent applications, I had been authorized to pay him up to \$2,000 for the time he spent reviewing the application. I received no response to this letter. This letter is attached as Exhibit K.

13. I spoke to Mr. Thielman on March 13, 2002 and asked if he had signed the Declaration or the assignment document. Mr. Thielman stated that he had not reviewed the application and did not plan to review it.

14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the present application or any patent issued thereon.

Dated: May 23, 2002

By: Arthur B. Moore
Arthur B. Moore
Chief Patent Counsel